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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,795	04/23/2001	Erin E. Murphy	15631007110	5250

20350 7590 06/18/2002

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EXAMINER
O HARA, EILEEN B

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 06/18/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/840,795	MURPHY ET AL.	
	Examin r	Art Unit	
	Eileen B. O'Hara	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   A. Claims 1-7, 9 and 10, drawn to nucleic acids, vectors, host cells and methods of recombinant protein expression, classified in class 536, subclass 23.1, for example.

   B. Claim 8, drawn to a method for detecting the presence of a nucleic acid molecule in a sample, classified in class 435, subclass 6.

   C. Claims 11-15, drawn to an binding compound comprising an antibody binding site and method for detecting protein, classified in class 530, subclass 388.22, for example.

   D. Claims 16-18, drawn to polypeptides, classified in class 530, subclass 350, for example.

   E. Claims 19 and 20, drawn to a method for modulating a precursor cell physiology or function comprising contacting a cell will a polypeptide, classified in class 424, subclass 85.2, for example.

The inventions are distinct, each from the other because of the following reasons:

The polynucleotides of invention A is related to the polypeptides of invention D by virtue of encoding the same. The polynucleotides have utility for the recombinant production of the protein in a host cell. Although the polynucleotides and proteins are related since the polynucleotides encode the specifically claimed proteins, they are distinct inventions because the protein products can be made by another materially different process, such as by synthesis or purification from the natural source. Further, the polynucleotides may be used for processes other than the production of the proteins, such as nucleic acid hybridization assays.

The proteins of invention D are related to the antibodies of invention C by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the protein and antibody are related due to the necessary stearic complementarity of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the natural receptor of the protein.

Invention A and each of inventions C and E are related as a process of making and a process of using a common product. The polynucleotides of invention A encode the polypeptides, which are used in the method of modulation of cell activity of invention E, and which polypeptides are the cognate antigens necessary for production of the antibody of invention C, but the nucleotides may also be used as probes in a method of hybridization, which are materially different methods. The processes are patentably distinct because of different starting and ending points, method steps and goals.

Inventions A and B are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of invention A can be used in the method of detection by hybridization of invention B, but the polynucleotides can also be used in a method of recombinantly producing protein, which is a materially different method.

Inventions D and E are also related as product and process of use. In the instant case the polypeptides of invention D can be used in the method of modulation of cell activity of invention E, but the polypeptides can also be used in a method of producing antibodies, which is a materially different method.

Invention C and each of inventions B and E are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the antibodies of invention C are not used or defined in the method of detecting polynucleotides by hybridization or in the method of modulation of cell activity with the polypeptides of invention D.

Invention D and B are also unrelated. In the instant case the polypeptides of invention D are not used or defined in the method of detecting polynucleotides by hybridization.

Inventions B and E are also unrelated. The methods of the inventions require different starting materials, and have different methods steps and goals.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, separate search requirements, and divergent subject matter, restriction for examination purposes as indicated is proper.

2. Restriction to one of the following inventions is also required under 35 U.S.C. 121:

Group I, as they pertain to SEQ ID NOS: 1 and 2, classification dependent upon the nature of the inventions.

Group II, as they pertain to SEQ ID NOS: 3 and 4, classification dependent upon the nature of the inventions.

Group III, as they pertain to SEQ ID NOS: 5 and 6, classification dependent upon the nature of the inventions.

Group IV, as they pertain to SEQ ID NOS: 7 and 8, classification dependent upon the nature of the inventions.

Group V, as they pertain to SEQ ID NOS: 12 and 13, classification dependent upon the nature of the inventions.

Group VI, as they pertain to SEQ ID NOS: 14 and 15, classification dependent upon the nature of the inventions.

Group VII, as they pertain to SEQ ID NOS: 16 and 17, classification dependent upon the nature of the inventions.

Group VIII, as they pertain to SEQ ID NOS: 18 and 19, classification dependent upon the nature of the inventions.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Each of SEQ ID NOS: 1, 3, 5, 7, 12, 14, 16 and 18 is a unique nucleic acid sequence encoding a unique protein, requiring a separate search of the prior art. Although some of the sequences may overlap, searching all of the sequences in a single patent application would provide an undue search burden on the examiner and the USPTO's resources because of the non-coextensive nature of these searches.

Furthermore, although each of the sequences represents a putative TNF-like receptor, each member of that class has unique and diverse functional features, which is also true for any splice variants, so that all are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different search, restriction for examination purposes as indicated is proper.

In order to be fully responsive, Applicant must select one from Groups A-E, and one from I-VIII. Applicant is advised that neither A-E nor I-VIII are species election requirements; rather, each of A-E and I-VIII is a restriction requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner

Yvonne Eyler

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SUPERVISORY PATENT EXAMINER
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